

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT W. SESSIONS

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Appeal No. 1998-0246  
Application No. 08/397,536

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HEARD: October 11, 2000

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Before COHEN, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17, 19, 20 and 22-24, which are all of the claims pending in this application.

### BACKGROUND

The appellant's invention relates to a method for packaging individual wound dressings. An understanding of the invention can be derived from a reading of exemplary claim 17, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Petersen et al. (Petersen)	3,140,572	Jul. 14, 1964
Seiden	4,436,576	Mar. 13, 1984
Dallaserra	4,455,809	Jun. 26, 1984

The following rejections are before us for review.

Claims 17, 19 and 22-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Petersen in view of Dallaserra.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Petersen in view of Dallaserra, as applied to claim 19 above, and further in view of Seiden.

Reference is made to the brief and reply brief (Paper Nos. 40 and 42) and the answer and supplemental answer (Paper Nos. 41 and 43) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In arriving at our decision on the obviousness issues raised in this appeal, we have given careful consideration to the appellant's specification and claims<sup>1</sup>, the teachings of the applied prior art references, the evidence supplied by the appellant, and the respective positions articulated by the appellant and the examiner. Having reviewed all of the evidence before us, we make the determinations which follow.

Turning first to the examiner's rejection of claims 17, 19 and 22-24 as being unpatentable over Petersen in view of Dallaserra. Petersen discloses a method of packaging surgical dressings, such as absorbent gauze and cut bandages and the like (column 1, lines 12-14). The Peterson method includes the steps of feeding a ribbon 10 of absorbent cotton or surgical gauze to feed rollers 12, 13 and cutting the ribbon into swatches of cotton or gauze using cut-off rollers 18, 19 having knives 20, 21. The piece of cotton or gauze enters between rollers 24, 25 before it is cut off by the knives 20, 21. As seen in Figure 1, the rollers 24, 25 also feed top and bottom heat sealable sheets 26, 27, which form upper and lower wrapping sheets 32, 33, with the cut swatches of cotton or gauze carried therebetween, to sealing rollers 35, 36, which help form a substantially perfect seal in the areas 51, 52 along the edges of the strip 32 and spaces 53 between the swatches 22. Petersen does not disclose how the cut

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<sup>1</sup> In claim 17, line 20, "the product" lacks clear antecedent basis. Based on a reading of the claim as a whole, we interpret "the product" as referring back to the "wound dressing product web" mentioned in lines 2 and 6 of claim 17. Likewise, we also interpret "web product" in claims 19 and 20, line 2, as referring back to the "wound dressing product web."

swatches are spaced from one another and is silent as to the relative rates at which the ribbon is fed by rollers 12, 13 and the wrapping sheets are fed by rollers 24, 25.

The examiner, finding that Petersen discloses the method as recited in claim 17, with the exception of the limitation that the first feed rate is greater than the second feed rate, relies upon the teachings of Dallaserra to remedy this deficiency. Dallaserra discloses a method for packaging an interior document in a sealed mailer so that it is free to move therein and is not secured to the outer sheets, i.e., for introducing a sheet section between the upper and lower sheets, without the section being held by the seal, but, on the contrary, remaining free in the interior of the sealed mailer so as not to interfere with its removal by the addressee (column 5, lines 42-49). Dallaserra's method involves feeding continuous upper and lower sheets 11, 12 at a first velocity  $V1$  and feeding a continuous intermediate sheet 10 at a second velocity  $V2$  between the upper and lower sheets, severing the intermediate sheet into discrete lengths  $E2$  and feeding the upper and lower sheets and the lengths of intermediate sheet to a sealing station 20 to unite the upper and lower sheets over the entire periphery of each of their sides by virtue of pressure rollers 22. In order to achieve the stated objective of introducing the intermediate sheet section between the upper and lower sheets such that it is free to move therein and is not secured to the outer sheets at the sealing station, the rollers 13 which feed the upper and lower sheets 11, 12 have a tangential velocity  $V1$  which is greater than the velocity  $V2$  at which the sheet 10 is fed to the rollers 13 (column 5, lines 50-68).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, a *prima facie* case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary skill in the art having those teachings before him to make the proposed combination or modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

One of ordinary skill in the art reading Petersen's disclosure would have appreciated that the cut swatches must be spaced from one another after they are severed from the ribbon and would have looked to known techniques for achieving such spacing. As evidenced by Dallaserra, one technique known in the prior art at the time of the appellant's invention for achieving such spacing was to feed the upper and lower sheets at a non-intermittent feed rate higher than the rate at which the severed insert strips are fed to the sheets. We share the examiner's opinion that the combined teachings of Petersen and Dallaserra would have suggested to one of ordinary skill in the art of packaging wound dressings at the time of the appellant's invention feeding the heat sealable sheets 26, 27 via rollers 24, 25 at a rate higher than the rate at which the ribbon of gauze or cotton is fed to the rollers 24, 25 in order to achieve the spacing between cut swatches 22 needed to accommodate the sealing of the upper and lower sheets to one another between the swatches.

The appellant (brief, page 4) argues that Dallaserra is non-analogous art to the appellant's invention and has filed a declaration by Raider Schmeichel (Paper No. 32) in support of this position. For the reasons which follow, we do not agree with the appellant in this regard.

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

We recognize that Dallaserra is directed to packaging paper mailers and not wound dressings and fully appreciate the declarant's stated belief that one concerned with packaging wound dressings at the time of the appellant's invention would not have turned to a patent dealing with a process and apparatus for manufacturing continuous sealed postal or other envelope assemblies (Schmeichel declaration, page 5). However, even if Dallaserra cannot reasonably be considered to be from the field of the appellant's endeavor, we share the examiner's opinion that it meets the second criterion for analogous prior art, in that it is reasonably pertinent to the problem with which the appellant is involved. As explained on page

27 of the appellant's specification, the appellant's invention involves laying cut wound dressings  
68 onto a faster moving envelope web 69 to thereby increase the spacing between the pieces  
68. Although Dallaserra faces this problem in a field of endeavor which may not be the same  
as the appellant's field of endeavor, Dallaserra also addresses the problem of spacing articles  
cut from a continuous web and laid onto a moving envelope web by feeding the envelope web  
at a speed greater than that at which the cut articles are fed. Thus, as we see it, one of  
ordinary skill in the art of packaging wound dressings, faced with the problem of achieving  
spacing between the cut swatches 22 in the Petersen method to accommodate sealing  
therebetween, would have considered the teachings of Dallaserra with regard to the relative  
feed velocities of the insert material and the wrapping sheets particularly pertinent in packaging  
wound dressing material within upper and lower wrapping sheets.

We understand the appellant's argument (brief, pages 4 and 5) that the severing  
techniques disclosed by Dallaserra, involving sudden acceleration or acceleration followed by  
deceleration, may not be acceptable for use with wound dressings. We must point out,  
however, that all of the features of the secondary reference need not be bodily incorporated  
into the primary reference (see In re Keller, 642 F.2d at 425, 208 USPQ at 881) and the  
artisan is not compelled to blindly follow the teaching of one prior art reference over the other  
without the exercise of independent judgment (see Lear Siegler, Inc. v. Aeroquip Corp., 733  
F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)). Moreover, skill is presumed on the

part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). In this instance, the examiner does not contend that one of ordinary skill in the field of making or packaging wound dressings would have found it obvious to replace the cut-off rollers 18, 19 of Petersen with the severing technique disclosed by Dallaserra. Rather, as emphasized by the examiner on page 6 of the answer, the examiner's position is that it would have been obvious to one of ordinary skill in the art to employ the relative feed velocities as taught by Dallaserra to achieve spacing.

The Schmeichel declaration points out on page 5 that Dallaserra does not provide the ability to inspect the location of the insert relative to where sealing would take place and that utilizing the Dallaserra method to even try and package differing sized inserts in the same package size would be extremely complicated. These statements, however, are not commensurate in scope with the appellant's claims, which require neither inspection, or capability of inspection, of the location of the insert relative to where sealing would take place nor packaging of different sized inserts in the same package size. It is well settled that evidence of nonobviousness must be commensurate in scope with the claims to which it pertains. In re Clemens, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980); In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979) and In re Tiffin, 448 F.2d 791, 792, 171 USPQ 294, 294 (CCPA 1971). See also In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983). Moreover, with particular regard to inspection, it appears that the use of transparent regenerated cellulose (cellophane)



wrapping material, as taught by Petersen (column 2, lines 22-25), would permit inspection of the location of the insert relative to where sealing would take place.

The statements in paragraph 7 (pages 6 and 7) of the Schmeichel declaration are not relevant to the obviousness rejection made by the examiner, in that these statements are directed to a proposed combination of a prior art method, which, in contrast to Petersen, uses suction or otherwise to mechanically move the cut web product from one location onto a moving web, and Dallaserra, rather than to the combination of Petersen and Dallaserra proposed by the examiner.

After reviewing all of the evidence before us, including the totality of the appellant's evidence, it is our conclusion that, on balance, the evidence of nonobviousness fails to outweigh the evidence of obviousness discussed above and, accordingly, the subject matter of claim 17, and claims 19 and 22-24 which stand or fall therewith (brief, page 3), would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 at the time the appellant's invention was made. See Richardson-Vicks Inc. v. Upjohn Co., 122 F.3d 1476, 1483, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997).

Accordingly, we shall sustain the examiner's rejection of claims 17, 19 and 22-24 as being unpatentable over Petersen in view of Dallaserra.

We shall not, however, sustain the examiner's rejection of claim 20 as being unpatentable over Petersen in view of Dallaserra and Seiden. Claim 20 recites that the sealing

of the first and second continuous webs along two sides of the cut product web is conducted at a first sealing station and that the sealing of the remaining two sides is conducted at a second sealing station. Petersen discloses sealing the upper and lower wrapping sheets on all four sides of the swatches (i.e., along the edges of the sheets and in the spaces between the swatches) at a single sealing station, using sealing rollers 35, 36 provided with recesses 49, 50, and pressure contact portions 45, 46 and edges 47, 48. Seiden discloses sealing two continuous sheets to one another by forming a continuous bottom seal 24 at a first sealing station 32 and a series of side seals 25 perpendicular to the bottom seals at a second sealing station 35. Even if Seiden would have suggested to one of ordinary skill in the art the use of two sealing stations to seal the upper and lower wrapping sheets of Petersen together, there is nothing in Seiden which would have suggested sealing the sheets along two sides of the swatch at one of the stations and sealing the sheets along the remaining two sides of the swatch at the other station, as specifically required by claim 20.

#### NEW GROUND OF REJECTION

Pursuant to the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection of claims 19 and 20.

Claims 19 and 20 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which fails to provide descriptive support for the subject matter now being claimed.

We initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). With respect to the description requirement, the court in Vas-Cath, 935 F.2d at 1563-64, 19 USPQ2d at 1117 stated:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the "written description" inquiry, *whatever is now claimed*.  
. . . drawings alone *may* be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

With these authorities in mind, we have carefully reviewed the original disclosure<sup>2</sup> and fail to find descriptive support for the limitations presently recited in claims 19 and 20 that the sealing of the first and second continuous webs along two sides of the cut web product is conducted at a first sealing station and the sealing of the first and second continuous webs along the remaining two sides of the cut web product is conducted at a second sealing station.

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<sup>2</sup> A review of this application, which was filed March 2, 1995, reveals that it is a continuation of Application No. 07/943,373, filed September 10, 1992, which is a continuation of Application No. 07/725,209, filed July 3, 1991, which in turn is a continuation of Application No. 07/417,285, filed October 5, 1989. The above-noted limitations of claims 19 and 20 were presented for the first time in a preliminary amendment filed March 27, 1995 (Paper No. 29).

With regard to sealing, the appellant's specification discloses, on page 27, that "suitable bonding of the top and bottom portions with the wound dressings 68 therebetween is accomplished by rolls 73 and 74, and rolls 75 and 76 in station 38." Further, Figure 14 illustrates two pairs of bonding rolls 73, 74 and 75, 76. Additionally, each of the original claims recited a step of "sealing said package top and said package bottom on at least three sides surrounding each cut piece of web." While this disclosure may provide support for providing two sealing stations, the first station comprising the set of bonding rolls 73, 74 and the second station comprising the set of bonding rolls 75, 76, it does not support sealing along two sides of the cut web product at the first station, as recited in claim 19, and sealing along the remaining two sides at the second station, as recited in claim 20.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 17, 19, 20 and 22-24 under 35 U.S.C. § 103 is affirmed as to claims 17, 19 and 22-24 and reversed as to claim 20. A new rejection of claims 19 and 20 under the first paragraph of 35 U.S.C. § 112 is entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat.

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Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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